

REMARKS

The terms of art in the Examiner's item 1, "single general inventive concept"; and "special technical features"; are explored in MPEP Annex B at AI-57 titled UNITY OF INVENTION. In that connection, applicant recognizes and respectfully asks the Examiner's concurrence that restriction practice in a U.S. national stage application is governed by PCT Rule 13; Rule 13.1 dealing with unity of invention and Rule 13.2 with special technical features. The concept of Unity of Invention, therefore, contains the aforementioned terms of art and governs said restriction practice.

Applicant respectfully invites the Examiner's attention to the PCT INTERNATIONAL SEARCH AND PRELIMINARY EXAMINATION GUIDELINES hereafter PCT/GL/ISPE, at page 19 of Chapter 2 thereof, paragraph 2.10(b) stating the role of the International Searching Authority to consider whether the application meets the requirement of unity of invention and more particularly to Chapter 10 thereof titled **Unity of Invention** wherein the above terms of art and PCT Rule 13 are more fully explored and explained with respect to **Determination of Unity of Invention** at paragraphs 10.01 through 10.04. Of particular interest with respect to the instant application are the opening and closing sentences of paragraph 10.04, stating:

"Although lack of unity of invention should certainly be raised in clear cases, it should neither be raised nor persisted in on the basis of a narrow, literal or academic approach. ... For determining the action to be taken by the examiner between these two extremes, rigid rules cannot be given and

each case is considered on its merits, the benefit of any doubt being given to the applicant.”

Paragraph 10.05, also of particular interest states:

“From the preceding paragraphs it is clear that the decision with respect to unity of invention rests with the International Searching Authority or the International Preliminary Examining Authority.”

Applicant further respectfully submits that the examiner’s requirement for restriction is improperly taken since the determination of Unity of Invention has already been made as required by PCT/GL/ISPE 2.10(b) during the performance of the International Search (IS) by the International Searching Authority (ISA) in the United States Patent and Trademark Office (USPTO) acting in that capacity. Since the ISA examiner in the USPTO found no lack of Unity of Invention, such finding of lack of Unity of Invention now by the national examiner in the USPTO constitutes an improper overruling of the ISA as administered by the USPTO.

It is well settled that the USPTO does accord different treatment to a domestically filed application and an application filed under the PCT in regard to restriction between a product and a method of making or using the product. Restriction between or among claims drawn to the product per se and to the method of making the product is permissible in a domestic application but impermissible in an international application where the process of making is specially adapted to the manufacture of the product, even though the product may have other uses than that claimed. In the MPEP Annex B at page A1-58 starting at about line 31 it is stated:

“The words “specially adapted” are not intended to imply that the product could not also be manufactured by a different process.”

Accordingly it has been and is the practice of the USPTO to not require restriction in an international application filed under either PCT Chapter I or Chapter II or in the national stage of a PCT application filed under 35 USC 371 between or among claims to (1) a product and a process of making the product and a method of using the product; or (2) a process and apparatus for performing the process; or (3) a product, a process of making the product , or an apparatus for performing the process.

Unity of Invention is also the title of the CFR section begun by 37 CFR § 1.475 in MPEP page R-134. The first sentence of 37 CFR § 1.475(a) is almost a verbatim re-write of PCT Rule 13.1 and the second sentence almost a verbatim re-write of PCT Rule 13.2. However, this section, 1.475, goes on to more fully define and explain the terse language of PCT Rules 13.1 and 13.2.

Applicant respectfully submits that the instant invention fulfills the provision of 37 CFR § 1.475 (b) (1) in that applicant has described and claimed only a product and a process specially adapted for the manufacture of said product.

Applicant believes and therefore respectfully submits that claims 1 through 12 are so closely related to claims 13 through 19 that they should remain in the same application so as to preserve unity of invention as explicated in 37 CFR § 1.475 and, in greater particularity to that section's (b)(1). Applicant further respectfully requests the Examiner's consideration of the conditional and permissive character of the application of 37 CFR § 1.499 with respect to 37 CFR § 1.475 thereby only permitting the Examiner's requirement for restriction if lack of unity of invention is found but not mandating the Examiner's requirement for such restriction.

Applicant respectfully requests that the Examiner's discretion be exercised in applicant's favor in accord with the suggestion of PCT/GL/ISPE 10.04 in the last sentence thereof and that the requirement for restriction be reconsidered and withdrawn.

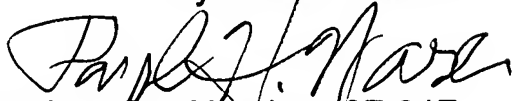
With respect to the Examiner's item 2, it is believed that, upon closer, more forbearing examination and in the light of the foregoing REMARKS, the relationship linking the Groups I and II so as to form a single general inventive concept and having the same or corresponding special technical features can be shown as required by 37 CFR § 1.475 (b)(1) and PCT Rules 13.1 and 13.2. Further to the Examiner's restriction requirement under 35 USC 121 and 372 the examiner's discretion in requiring or not requiring restriction is noted. Thus the Examiner may require or not require restriction at his discretion.

Applicant respectfully requests the Examiner to exercise his discretion in applicant's favor as suggested in PCT/GL/ISPE in the last sentence of 10.04 thereof. Applicant therefore requests that the Examiner reconsider and withdraw his requirement for restriction.

Respectfully submitted,

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